

REMARKS

The Office Action mailed on May 27, 2009 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 32-69 are pending in the current case. Claim 34 is cancelled without prejudice. Applicants reserving the right to pursue these claims at a later time. New claims 70-72 are respectfully submitted for consideration by the Examiner. No new matter has been introduced by the addition of claims 70-72.

Claims 39, 47, and 60-69 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Regarding claims 39, 60-69, the current Office Action asserts that the specification fails to describe gels or liquids which are resilient and shape-retaining. While not necessarily acquiescing to this assertion, and in order to advance the present application, independent claims 32, 48, and 53 have been amended to obviate the rejection by deleting the limitation of a material that is a resilient, shape-retaining synthetic material. Regarding claim 47, claim 47 has been amended to obviate the rejection.

Claims 33, 40, 44, 51-52, and 56-57 stand rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 33, 40, 44, 51-52, and 56-57 have been amended to obviate the rejection.

Claims 32-69 stand rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,749,634 ("Hanna"), or in the alternative as being unpatentable over Hanna in view of USPN 4,888,012 ("Horn"). Such rejections are traversed in part and overcome in part as follows.

Independent claim 32 is directed to an implantable intraocular lens comprising, in pertinent part, an optic and a positioning member operably coupled with the optic and responsive to ciliary body movement in order to change the shape of the optic between a first optic shape and a second optic shape, where the second optic shape has a thickness that is greater than the first optic shape, wherein the positioning member comprises an outer body and a plurality of spaced-apart arms extending radially between the optic and the outer body in an equatorial plane when the optic has the first shape and when the optic has the second shape,

wherein accommodation is achieved when the optic changes from the first shape to the second shape so as to increase diopter power value of the optic.

Hanna does not disclose all the limitations of claim 32 as amended. For example, Hanna does not disclose, or even suggest, an optic having two different shapes or thicknesses. To the contrary, Hanna discloses providing accommodation in response to radial forces produced by changes in capsular bag diameter. Hanna, column 3, lines 43-45. Furthermore, Hanna does not disclose or suggest a lens in which accommodation is achieved when the optic changes from a first shape to a second shape having a greater thickness so as to increase diopter power value of the optic. To the contrary, Hanna discloses accommodation due to axial movement of a central lens. Hanna, column 6, lines 52-53 and FIGS. 15-18.

The current Office Action alleges that Hanna provides optic material which is capable of deformation to produce different thicknesses, and thus the structure of Hanna anticipates claim 32. The Office Action seemingly is alleging that Hanna would inherently produce a change in optic shape. However, MPEP 2112 (IV) indicates that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Applicants respectfully assert that the Office Action does not meet the burden to provide a rationale or evidence tending to show inherency. Indeed, rather than suggesting a lens that changes shape and achieves accommodation by increasing diopter power value of an optic, as required by claim 32, Hanna instead discloses achieving accommodation an entirely different mechanism, specifically, via axial motion of a lens.

Furthermore, Hanna does not disclose a plurality of spaced-apart arms extending radially between an optic and an outer body in an equatorial plane when the optic has a first shape and when the optic has a second shape. Rather, Hanna discloses arms that rotate about a hinge so as to move a lens forward in response to radial forces. Hanna, column 3, lines 19-40 and FIGS. 15-18.

Independent claims 48 and 53 have limitations similar to those of claim 32 and are patentable over Hanna at least for some of the same reasons that claim 32 is patentable thereover, and are patentable in their own right as well.

Regarding the rejection over Hanna in light of Horn, the current Office Action contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to

replace the vaulting optic lens assembly of Hanna to include a liquid or gel filled lens that changes shape, as taught by Horn, in order to provide greater range of accommodation for patients in need of greater accommodation ranges. Applicants respectfully traverse this contention, since the disclosure of Hanna actually teaches away from a lens that changes shape, as allegedly taught by Horn.

More specifically, Hanna discloses an accommodating intraocular implant constituting a central lens and at least two haptic portions in the form of radial arms each including free end fitted with a shoe, the connection between each shoe and the corresponding arm being of the hinge type, wherein any movement tending to bring the shoes towards the center of the lens causes the lens to move forwards. Hanna, column 3, lines 19-40. Hanna further discloses arm hinges configured so that when radial compression is applied to the shoes it generates movement of a lens or optic in an axial direction along an optical axis of the lens or optic. Hanna, FIG. 2 and column 6, lines 41-45.

By contrast, Horn discloses lens structures which have the ability to be extended or compressed when appropriate radial force or pressure is applied thereto and to essentially return to their original shapes when such radial force or pressure is relaxed. More specifically, as radial tension transmitted from a ring to a central lens is relaxed, the lens contracts its diameter. Subsequently, as outer ring tension is increased on the lens via muscle relaxation, the lens will expand its diameter as a function of the tension exerted thereon so that the shape of the lens will revert to the original non-accommodative form. Horn, column 2, lines 44-68. In a specific embodiment, an outer ring 44 transmits radial tension to the central lens 12 via the strips 84 which comprise the web member 50 in order to stretch the lens 12 radially outwardly. Horn, column 8, lines 1-14.

In summary, Hanna discloses an intraocular implant in which radial forces or pressure are converted to an axial force that moves an optic in an axial direction. By contrast, Horn discloses an optic requiring radial forces or pressure change the shape of an optic.

Thus, it has been shown that Hanna teaches away from providing the radial forces on an optic required by Horn, instead disclosing a structure that produces axial forces for axially moving an optic. Accordingly, Applicants assert that claim 32 is patentable over Hanna and Horn since, contrary to the assertion made in the current Office Action, it would not have been

obvious to one of ordinary skill in the art at the time of the invention to replace the vaulting optic lens assembly of Hanna to include a lens that changes shape, as taught by Horn.

In addition, various of claims depending from independent claims 32, 48, or 53 further distinguish over both Hanna and Horn. For example, neither Hanna nor Horn, either alone or in combination, disclose positioning member having, in combination with the other limitations of claims 48 or 53, anterior segments that intersect a first plane that is perpendicular to an axis, posterior segments intersect a second plane that is perpendicular to the axis, and an entirety of the optic is disposed between the first plane and the second plane when the optic has the first shape and when the optic has the second shape, as recited in claims 51 and 56.

Accordingly, for all the reasons indicated above independent claims 32, 48, and 53 are patentable over Hanna and Horn. Applicants therefore request the Examiner allow independent claims 32, 48, and 53. Claims 33, 35-47, 49-52, and 54-69, as well as new claims 70-71 depend from claims 32, 48, or 53 and further define the invention of claims 32, 48, or 53. Thus, claims 33, 35-47, 49-52, and 54-71 are patentable over Hanna and Horn at least for the same reasons that claim 32, 48, and 53 are patentable thereover, and are patentable in their own right as well.

CONCLUSION

For the foregoing reasons, Applicant respectfully asserts that the claims now pending are allowable over the prior art of record. Therefore, Applicant earnestly seeks a notice of allowance and prompt issuance of this application.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication to Deposit Account No. 502317.

Respectfully submitted,
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